

REMARKS

In the Office Action mailed April 5, 2005, claims 44-47 and 50-58 and 60-80 were pending. Claims 44, 47, and 60-80 stand rejected, and claims 45, 46 and 50-58 were objected to as depending from a rejected base claim but were indicated to be allowable if rewritten to include all the limitations of the base claim and any intervening claims. In the advisory action mailed June 16, 2005, the reply filed on June 6, 2005 was not entered since it was asserted that the proposed amendment would raise issues under 35 USC 112. In this response claims 44 and 60 have been cancelled, and new independent claim 45 and previous independent claims 47 and 71 have been amended to place the claims in condition for allowance. Claims 61-65 and 68-70 have been amended to provide consistency in terminology with amended claim 47, correct grammatical errors, and/or to provide proper dependency in view of the cancellation of claim 60. Claims 73, 75, and 79 have been amended to correct grammatical errors and improve form. Reconsideration of the present application as amended and including claims 45-47, 50-58 and 61-80 in view of the remarks that follow is respectfully requested.

Claims 47 and 60-80 were rejected under 35 U.S.C. §101, 35 U.S.C. §112, first paragraph and 35 U.S.C. §112, second paragraph. In this response, claims 47, 61-65, 68, 69, 71, 73, 75, and 79 have been amended to address the concerns raised in the office action and advisory action and to place the present application in condition for allowance. Withdrawal of the rejection of these claims is respectfully requested. However, Applicants do not acquiesce in the rejections and reserve the right to pursue the claims as originally submitted in a continuing application.

Claim 44 was rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,471,725 to Ralph et al. It is noted that Ralph et al. is provisionally prior art under 35 U.S.C. §102(e). Applicants reserve the right to swear behind the filing date of Ralph et al. with an affidavit under 37 CFR §1.131 in this application or in any related applications.

Claim 44 has been cancelled, and claim 45 has been rewritten in independent form. Accordingly, claim 45 is allowable as indicated in the Office Action along with claims 46 and 50-58 depending therefrom.

Claims 47, 60-66 and 70 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,471,725 to Ralph et al. Claim 47 has been amended to recite the features in original claim 45. Claim 47 is allowable at least since original claim 45 was allowable. Claim 60 has been cancelled, and claims 61-65 and 69 have been amended to provide consistency in terminology and proper dependency in view of the cancellation of claim 60. Accordingly, claim 47 along with claims 61-70 depending therefrom are allowable.

Response to Advisory Action and to Final Office Action
Ser. No. 10/790,329
Atty Docket No. 4002-3486/PC746.02
Page 8 of 10

Claims 71-78 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,471,725 to Ralph et al. Assuming *arguendo* that Ralph et al. were prior art, it does not anticipate claim 71 as amended for the same reasons claim 45 is allowable. "[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989.) The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984).

Claim 71 is directed to a method for restoring a collapsed spinal disc space and recites "providing a number of implants each having a body with a leading end nose defining a leading end height sized for insertion into a collapsed disc space and convexly curved upper and lower surfaces extending from the leading end nose to a trailing end of the body, the convexly curved upper and lower surfaces defining a maximum distraction height, each of the number of implants having the same leading end height and a differing maximum distraction height; sequentially inserting and removing the number of implants into the collapsed spinal disc space, the spinal disc space being at least partially collapsed when each implant is removed; selecting the implant with the maximum distraction height providing a desired disc space height; and leaving in the spinal disc space the selected implant to post-operatively maintain the desired disc space height."

Ralph et al. does not disclose "each of the number of implants having the same leading end height and a differing maximum distraction height". Rather, as shown in Figures 3d and 4d of Ralph et al., each of the implants has a different leading end height. Accordingly, since at least this feature in claim 71 is not disclosed in Ralph et al., claim 71 cannot be anticipated thereby and withdrawal of this basis of the rejection is respectfully requested.

Furthermore, Ralph et al. discloses that the last inserted trial spacer providing the desired disc space height is removed from the spinal disc space and does not post-operatively maintain the desired disc space height. Ralph et al. does not disclose an implant or a spacer with convexly curved upper or lower surfaces. Rather, the surfaces are either parallel or tapered. Ralph et al. therefore cannot anticipate claim 71. Accordingly, withdrawal of this basis of the rejection of claim 71 is respectfully requested.

Claims 72-78 depending from claim 71 are allowable at least because claim 71 is allowable and for other reasons. For example, there is no disclose that "the leading end height is

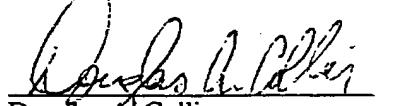
Response to Advisory Action and to Final Office Action
Ser. No. 10/790,329
Atty Docket No. 4002-3486/PC746.02
Page 9 of 10

about 3 to 4 millimeters" as recited in claim 72. This feature is also recited in claims 46, which was indicated to be allowable. There is also no disclosure that "the leading end nose of each of the implants includes a rounded surface profile extending between the upper and lower surfaces of the body of the implant." Rather, Ralph et al. discloses the leading end is interrupted with a notch. Claim 75 recites "wherein the body of each implant includes: a first lateral surface extending between the upper and lower vertebral surfaces; and a second lateral surface opposite of and extending parallel to the first lateral surface and further extending between the upper and lower surfaces." Ralph et al. fails to disclose any implant with parallel lateral surfaces.

Accordingly, withdrawal of this basis of the rejection of claims 72-78 is respectfully requested.

Allowance of the present application as amended and including claims 45-47, 50-58 and 61-80 in view of this response is respectfully requested. The amendments do not raise new issues for consideration by the Examiner, and are believed to place the claims in condition for allowance. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted:



Douglas A. Collier
Reg. No. 43,556
Krieg DeVault LLP
2800 One Indiana Square
Indianapolis, Indiana 46204-2079
Phone: (317) 636-4341